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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,586	11/22/2000	Bernard Bendiner	5565x4	1239

7590 11/12/2003

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

*The copy*

Application No.

09/721,586

Applicant(s)

BENDINER, BERNARD

Examiner

JYOTHSNA A VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-37 is/are allowed.
- 6) ☒ Claim(s) 38-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The examiner in this application is changed from Sharon Howard to **Jyothsna Venkat**.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claims 1-59 are pending in the application and the status of the claims are as follows:

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 40, 42, 47, 49, 57 and 59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

4. There is no support in the specification for the expression” **non-waxed new paper**”. The support in the patent 5,840, 249(‘249) are for “ virgin vegetable matter, waste waxed paper, and new waxed paper” at col.4, last paragraph and for non-waxed waste paper at col.5, line 33. There is no support in the patent for “ **wherein the paraffin wax is food grade**”.

5. **In accordance with MPEP 714.02, applicants should specifically point out support for any amendments made to the disclosure.**

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6. Claims 41, 48, and 57-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

Claims 41, 48 and 58 recite, "Wherein the wax is obtained from paraffin wax". Paraffin wax itself is a wax, so how can the wax be obtained from wax? Additionally, the paper is coated with wax to form wax paper. Therefore detailed explanation is requested with respect to wherein the wax is obtained from paraffin wax.

Claims 57-59 lack antecedent bases with respect to "preservative". Note that claim 53 recites "product".

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 38-41, 43-48, and 51-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,822,178('178) and 3,655,400('400).

The instant application is claiming a process, preservative for organic matter and a decomposition product comprising cellulose and wax and the product is filtered through a very fine filter and further comprising:

1. potassium sorbate
2. citric acid

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3. non-ionic emulsifier

The patent '178 teaches process for repulping waxed paper using non-ionic emulsifier where in the paper comprises wax and cellulose as claimed and passing it through very fine filter. See the claims . The difference between the patent and the instant application is that the patent does not disclose adding citric acid to lower the PH and adding potassium sorbate to the product. One of ordinary skill in the art with a scientific knowledge would add a weak acid like citric acid so that PH is 6.5 or lower. The patent '400 is cited to show that in order to have shelf or product stability potassium sorbate is added. See col.1, last paragraph.

Accordingly it would have been obvious to one of ordinary skill in the art, at the time the invention was made to prepare the product of '178 and add potassium sorbate and add citric acid. The motivation to add potassium sorbate stems the teachings of patent '400 that this compound prevents mold development and shelf instability. One of ordinary skill in the art having scientific knowledge would add weak acid like citric acid to lower the Ph. One of ordinary skill in the art would have reasonable amount of success by taking the product of '178 and adding potassium sorbate so that the product can be used as a preservative and decomposition resistant product because potassium sorbate when added has the advantage of preventing mold development and shelf instability. This is a prima facie case of obviousness.

***Allowable Subject Matter***

9. Claims 1-37 are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-

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2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



**JYOTHSNA A VENKAT**  
Primary Examiner  
Art Unit 1615

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